

Appl. No. 09/595,256
Amdt. Dated: April 15, 2005
Reply to Office Action of January 19, 2005

• • R E M A R K S / A R G U M E N T S • •

The Official Action of January 19, 2004 has been thoroughly studied. Accordingly the changes presented herein for the claims, considered together with the following remarks, are believed to be sufficient to place the application into condition for allowance.

By the present amendment, independent claim 1 has been changed to recite that the elastic zone is nonmonolithically formed with the covering zone.

This change to claim 1 adapts the language that the Examiner courteously suggested under the rejection of claims 1-6 and 8 under 35 U.S.C. §112, second paragraph.

In addition, claim 1 has been changed to recite that the second member is attached to the terminal longitudinal edge of said covering zone.

This change again adapts the language that the Examiner suggested under the rejection of claims 1-6 and 8 under 35 U.S.C. §112, second paragraph.

Finally, claim 8 has been changed to correct the typographical error noted by the Examiner on page 6 of the Office Action.

It is believed that the changes to the claims are properly enterable after Final Rejection in as much as they are limited to adopting changes suggested by the Examiner.

Accordingly entry of the changes to claims 1 and 8 is respectfully requested.

Claims 1-6 and 8 are pending in this application.

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Claims 1-6 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,601,547 to Kato et al.

Claim 8 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kato et al. in view of European Patent Application No. 0 688 550 to Kimberly-Clark and U.S. Patent No. 4,397,646 to Daniels et al.

For the reasons set forth below, it is submitted that all of the pending claims are allowable over the prior art relied upon by the Examiner and therefore, each of the outstanding prior art rejections should properly be withdrawn.

Favorable reconsideration by the Examiner is earnestly solicited.

In applying the teachings of Kato et al. to claims 1-3 the Examiner has relied upon Kato et al. in the paragraph bridging columns 32-33 and at column 33, lines 17-32 as teaching that the top layer 108 "may be smaller" in transverse width than base layer 98.

The Examiner has also relied upon Kato et al. at column 4, lines 55-60 as teaching that the waist border 36 "desirably" includes an extension of one of the layers of chassis 22, for example, an extension of outer layer 50 (FIG. 2).

The Examiner states that the statement that the top layer 108 "may be smaller" in transverse width than base layer 98 "infers [it] may not be smaller."

The Examiner states that the statement that the waist border 36 "desirably" includes an extension of one of the layers of chassis 22, for example, an extension of outer layer 50 (FIG. 2) "does not require extension of one of the layers."

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It seems that a prior art reference should only be relied upon for what it actually teaches and not for what it fails to exclude. Otherwise, paragraphs such as:

While this invention has been described as having preferred embodiments, it will be understood that it is capable of further modifications. This application is therefore intended to cover any variations, equivalents, uses or adaptations of the invention following the general principles thereof, and including such departures from the present disclosure as come within known or customary practice in the art to which this invention pertains and falls within the limits of the appended claims.

found before the claims in Kato et al. could reasonably be interpreted as a "teaching" of all possible "further modifications" and "any variations, equivalents, uses or adaptations." This is not the case as much as it is not the case that references to "desirably," "preferably," etc. present open-ended prior art teachings.

The concept of relying upon a reference as a whole and interpreting the teachings of a reference in context of the reference has been set forth in the CCPA's holding in *In re Wesslau* where the court of appeals clearly stated:

It is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *In re Wesslau*, 147 USPQ 391, at 393 (CCPA 1965).

In the present situation the isolated portions of Kato et al. which the Examiner has relied upon can more easily be interpreted as being consistent with the overall teachings of Kato et al., than be interpreted as allowing for structures and/or functions that Kato et al. does not teach or exclude.

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Quite simply Kato et al teaches two embodiments of the waist portion of the pants which are shown in Figs. 2 and 3.

In Fig. 2 the elastic zone 60 is attached to a portion of the outer layer 50 (the Examiner's "backsheet") which extends beyond the liner 48 (the Examiner's "topsheet").

In Fig. 3 the elastic zone 60 is not nonmonolithically formed from the outer layer 50, but is rather formed from an extension of outer layer 50.

Clearly, neither of the embodiments shown in Figs. 2 or 3 is similar to applicant's claimed invention.

Kato et al. teaches two methods or processes for manufacturing the training pants.

Figure 4 depicts a method of process for manufacturing training pants that have the elastic zone structure depicted in Fig. 3, i.e. in which the elastic zone 60 is formed by folding a portion of outer layer 50 (base layer 142 in Fig. 4) that extends beyond liner 48 (top layer 150 in Fig. 4). Note at column 34, lines 39-40 Kato et al. expressly states: "With reference to FIG. 4, a description will be made of one method for making the modification in FIG. 3."

Figure 6 depicts a method or process for manufacturing training pants that have the elastic zone structure depicted in Fig. 2, i.e. in which the elastic zone 60 is attached to a portion of the outer layer 50 (base layer 98 in Fig. 6) that extends beyond the edges of liner 48 (top layer 108 in Fig. 6). Note the repeated reference to the method of process of Fig. 6 being used to form the embodiment shown in Fig. 2.

Note specifically that at column 2, lines 56-59 Kato et al. state that:

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FIG. 4 is a schematic diagram illustrating one method for making an embodiment similar to that in FIG. 3;

FIGS. 5 and 6 schematically illustrate one method for making an embodiment similar to that in FIG. 2

Once it is recognized that Kato et al. teaches only the two embodiments shown in Figs. 2 and 3 and only teaches two methods or processes for making the embodiments, it becomes clear that the portions of Kato et al., which the Examiner relies upon only refer to the two embodiments.

For example at column 33, lines 29-32 Kato et al. states:

Top layer 108 may be smaller in transverse width than base layer 98, and thus may not be in contact with elastic composites 97, 112. The elastic composites 97, 112 will form elongate sleeve member 62 (FIG. 2).

The reference "may be smaller" has to be considered in the context of "may be smaller...and thus...[may not be in contact with elastic composites 97, 112]."

It is important to recognize that Kato et al. expressly teaches that:

The present invention provides an improved waist elastic system for children's training pants that results in a substantially uniform low tension along the peripheral border of the waist opening over a wide size range, a more comfortable fit, and improved ease of use by the child over an extended period of use. This is accomplished by, among other things, reducing the number of layers of material, i.e., the mass or amount of material, that the waist elastic system must gather. The more material there is to gather, the more the elasticity will be degraded or reduced in gathering the excess material. The present invention reduces this number of layers or amount of material to be gathered by incorporating an elastic member in, for example, one layer of material, thereby reducing loss of elasticity. (Column 4, lines 2-15)

and:

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Desirably, waist elastic system 60 is joined to only one of the layers comprising chassis 22, such as outer layer 50. (Column 5, lines 19-21)

Clearly the express teachings of Kato et al. conform to the two embodiments shown in Figs. 2 and 3 and the method or process of manufacturing these two embodiments as shown in Figs. 4-6.

If anything, Kato et al. expressly teaches away from the attaching the elastic zone 60 to a portion of the diaper body where the inner layer 52, outer layer 50 and liner 48 would overlap or extend co-extensively.

As specifically recognized by Kato et al. such a modification would require the elastic zone 60 to be joined to two or more layers with the adverse affect of increasing the "number of layers or amount of material to be gathered by incorporating an elastic member in, for example, one layer of material, thereby reducing loss of elasticity." (Kato et al., column 4, lines 12-15)

Since Kato et al. does not specifically teach such a modification (and in fact teaches against it), at best the Examiner could only urge that such a modification was obvious. Kato et al. clearly does not anticipate applicant's claimed invention.

Moreover, under the Board or Appeals' holding in *Ex parte Hartmann* that:

References cannot properly be combined if effect would destroy invention on which one of reference patents is based. *Ex parte Hartmann*, 186 USPQ 366 (PTO Bd App 1974)

applicants submit that such a modification to Kato et al. would destroy the goal of Kato et al. to reduce "the number of layers of material, i.e., the mass or amount of material, that the waist elastic system must gather" and "thereby reduce[e] loss of elasticity."

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The Examiner has relied upon each of Kimberly-Clark and Daniels et al. as teaching elastic systems for leg openings.

The Examiner's further reliance upon each of Kimberly-Clark and Daniels et al. does not address or overcome the differences between the present invention and Kato et al. as discussed above.

Based upon the above distinctions between the prior art relied upon by the Examiner and the present invention, and the overall teachings of prior art, properly considered as a whole, it is respectfully submitted that the Examiner cannot rely upon the prior art as required under 35 U.S.C. §102 as anticipating applicant's claimed invention.

Moreover the Examiner cannot properly rely upon the prior art as required under 35 U.S.C. §103 to establish a *prima facie* case of obviousness of applicant's claimed invention.

It is, therefore, submitted that any reliance upon prior art would be improper inasmuch as the prior art does not remotely anticipate, teach, suggest or render obvious the present invention.

It is submitted that the claims, as now amended, and the discussion contained herein clearly show that the claimed invention is novel and neither anticipated nor obvious over the teachings of the prior art and the outstanding rejections of the claims should hence be withdrawn.

Therefore, reconsideration and withdrawal of the outstanding rejection of the claims and an early allowance of the claims is believed to be in order.

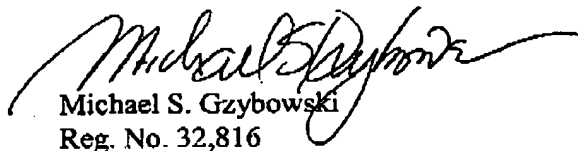
It is believed that the above represents a complete response to the Official Action and reconsideration is requested.

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If upon consideration of the above, the Examiner should feel that there remain outstanding issues in the present application that could be resolved, the Examiner is invited to contact applicant's patent counsel at the telephone number given below to discuss such issues.

To the extent necessary, a petition for an extension of time under 37 CFR §1.136 is hereby made. Please charge the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 12-2136 and please credit any excess fees to such deposit account.

Respectfully submitted,


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